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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER

TRAVERS, RUSSELL S

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 07/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/272,821

Applicant(s)

Uckun et al

Examiner

R.S. Travers J.D., Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-44 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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The response filed April 23, 2003 has been received and entered into the file.

Applicant's arguments filed April 23, 2003 have been fully considered but they are not deemed to be persuasive.

Claims 23-44 are presented for examination.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, and thereby failing to provide an enabling disclosure.

The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation. Attention is directed to *In re Wands*, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApls 1986) at 547 the court recited eight factors:

- 1) the quantity of experimentation necessary,
- 2) the amount of direction or guidance provided,
- 3) the presence of absence of working examples,

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- 4) the nature of the invention,
- 5) the state of the prior art,
- 6) the relative skill of those in the art
- 7) the predictability of the art, and
- 8) the breadth of the claims.

Applicant fails to set forth the criteria that allows the skilled artisan to identify those HIV strains "resistant to a chemotherapeutic agent". *See Spm P 5-230-31* Additionally, Applicant fails to provide information allowing the skilled artisan to ascertain these compounds without undue experimentation. In the instant case, only a limited number of HIV strains "resistant to a chemotherapeutic agent" examples are set forth, thereby failing to provide sufficient working examples. It is noted that these examples are neither exhaustive, nor define the class of compounds required. The pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. The instant claims read on all HIV strains "resistant to a chemotherapeutic agent", necessitating an exhaustive search for the embodiments suitable to practice the claimed invention. Applicants fail to provide information sufficient to practice the claimed invention, absent undue experimentation.

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Claims 23, 25, 26, 29, 30, 31, 34, 35, 36, 39, 41 and 42 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 23, 25, 26, 29, 30, 31, 34, 35, 36, 39, 41 and 42 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 23, 25, 26, 29, 30, 31, 34, 35, 36, 39, 41 and 42 are rendered indefinite by the phrase HIV strains "resistant to a chemotherapeutic agent" and thereby failing to clearly set forth the metes and bounds of the patent protection desired. Criteria defining HIV strains "resistant to a chemotherapeutic agent" are not set forth in the specification, thereby failing to provide information defining the instant inventions metes and bounds. Applicant's term fails to clearly define the subject matter encompassed by the instant claims, thus is properly rejected under 35 USC 112, second paragraph.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

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Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 23-44 are rejected under 35 U.S.C. § 103 as being unpatentable over Lind et al.

Lind et al and et al teach the claimed compounds as old and well known in combination with various pharmaceutical carriers and excipients in a dosage form. These medicaments are taught as useful for treating viral infections generally, specifically HIV, as herein claimed (see specifically page 15). Claims 23-44, and the primary reference, differ from the claimed invention by not reciting treatment of specific resistant HIV strains. Attention is directed to Lind et al page 3, lines 20-24 setting forth the issue of HIV resistance to conventional antiviral agents, and the concept the instant compounds overcome this problem. Possessing this teaching, the skilled artisan would see the instant compounds, taught as anti-HIV by Lind et al, as useful for treating resistant HIV strains, absent information to the contrary.

It is generally considered prima facie obvious to employ compounds taught as inhibiting viral replication as therapeutic for this same condition. The idea for employing them flows logically from their having been used individually in the prior art.

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As shown by the recited teachings, the instant claims define nothing more than the use of conventional anti-HIV agents.

RESPONSE TO ARGUMENTS

Those rebuttal arguments set forth in the response filed April 23, 2003 fail to address problems residing in the rejected claims. Although claims 24, 27, 28, 32, 33, 37, 40 and 43-44 provide those compounds of interest to individuals attempting to practice the instant claims, the rejected claims place the burden of undue experimentation on the public to ascertain those situations herein envisioned. Those compounds, or levels of resistance, herein envisioned are neither specifically set forth, nor provided via guidance in the instant specification to the routeineer. Simply stated, the invention as set forth in the rejected claims is an invitation for the skilled artisan to experiment.

Attention is directed to *General Electric Company v. Wabash Appliance Corporation et al* 37 USPQ 466 (US 1938), at 469, speaking to functional language at the point of novelty as herein employed: "the vice of a functional claim exists not only when a claims is "wholly" functional, if that is ever true, but when the inventor is painstaking when he recites what has already been seen, and then uses conveniently functional language at the exact point of novelty". Functional language at the point of

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novelty, as herein employed by Applicants, is further admonished in *University of California v. Eli Lilly and Co.* 43 USPQ2d 1398 (CAFC 1997) at 1406: stating this usage does "little more than outlin[e] goals appellants hope the recited invention achieves and the problems the invention will hopefully ameliorate". Applicants functional language at the point of novelty fails to meet the requirements set forth under 35 USC 112, first paragraph. Claims employing functional language at the point of novelty, such as Applicants', neither provide those elements required to practice the inventions, nor "inform the public during the life of the patent of the limits of the monopoly asserted" *General Electric Company v. Wabash Appliance Corporation et supra*, at 468. Claims thus constructed provide no guidance as to medicaments employed, levels for providing therapeutic benefit, or provide notice for those practicing in the art, limits of protection. Simply stated, the presented claims are an invitation to experiment, not reciting a specific medicament regimen useful for practicing the instant invention.

Forcing the burden of undue experimentation on the skilled artisan fails to establish those metes and bounds envisioned for the instant invention. Absent meaningful limitations the instant claims fail to provide any criteria for identifying the limits of protection herein envisioned. Functional limitations relied on by Applicants fail to meet the required burden of notice place on those seeking to patent protection.

Again, Applicants aver unexpected benefits residing in the claimed subject matter, yet fail to set forth evidence substantiating this belief. Evidence as to

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unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972). The data provided by Applicants is not clear, convincing or reasonably commensurate in scope with the instant claims. Absent a clear, convincing showing commensurate with a showing of unexpected benefits, or a showing reasonably commensurate with the instant claims, such claims remain properly rejected under 35 USC 103.

It is well known by the skilled artisan that carriers and excipients are employed to enhance the activity of active ingredients. Thus, the skilled artisan would expect conventional excipients and carriers to be useful concomitantly, absent information to the contrary. The instant carriers and excipients are not employed concomitantly in the prior art, thus only obviate their concomitant use.

Applicant's attention is drawn to In re Graf, 145 USPQ 197 (CCPA 1965) and In re Finsterwalder, 168 USPQ 530 (CCPA 1971) where the court ruled that when a substance is unpatentable under 35 USC 103, it is immaterial that applicant may have disclosed an obvious or unobvious further purpose or advantage for the substance.

Examiner would favorably consider claims directed to those medicaments providing unexpected therapeutic benefits, as averred herein.

The instant claims are directed to effecting an old and well known therapeutic use with an old and well known compound, wherein a biochemical system may have

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been altered. Arguments that such claims are not directed to the old and well known ultimate utility for this compound are not probative. It is well settled patent law that mode of action elucidation does not impart patentable moment to otherwise old and obvious subject matter. Applicant's attention is directed to In re Swinehart, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated "is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art.". Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to requires the applicant to prove that the subject matter shown to be in the prior art dose not posses the characteristic relied on. In the instant invention, the claims are directed to the ultimate utility set forth in the prior art, albeit distanced by various biochemical intermediates. The ultimate utility for the claimed compounds is old and well known rendering the claimed subject matter obvious to the skilled artisan. It would follow therefore that the instant claims are properly rejected under 35 USC 103.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the

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shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to Russell Travers at telephone number (703) 308-4603.

A handwritten signature in black ink, appearing to be 'RT' or similar initials, enclosed within a circular flourish.

Russell Travers J.D., Ph.D.
Primary Examiner
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